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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Sharp Kabushiki Kaisha
a/t/a Sharp Corporation

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Serial No. 75/392,138

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Robert W. Adams of Nixon & Vanderhye P.C. for Sharp Kabushiki Kaisha a/t/a Sharp Corporation.

Esther A. Borsuk, Trademark Examining Attorney, Law Office 113 (Meryl Hershkowitz, Managing Attorney).

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Before Simms, Seeherman and Hanak, Administrative Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

Sharp Kabushiki Kaisha a/t/a Sharp Corporation (applicant), a Japanese corporation, has appealed from the final refusal of the Trademark Examining Attorney to register the mark SCANNING STATION for personal computer software for imaging scanners.[1] The Examining Attorney has refused registration under Section 2(e)(1), arguing that

applicant's mark is merely descriptive of its goods. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held. We affirm.

We first deal with procedural issues. The Examining Attorney has objected to third-party registrations submitted with applicant's supplemental appeal brief. It is the Examining Attorney's position that, under Trademark Rule 2.142(d), applicant may not submit such evidence with its appeal brief. Applicant, on the other hand, points to the Examining Attorney's submission of evidence in her response to applicant's request for reconsideration as justification for the submission with its supplemental appeal brief.[2]

Generally, the evidentiary record in an application should be complete prior to the filing of an appeal, and additional evidence filed after the appeal will normally be given no consideration. See TBMP § 1207.01. If an applicant or an Examining Attorney wishes to introduce additional evidence after an appeal is filed, the applicant or Examining Attorney may file a request with the Board

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[1] Application Serial No. 75/392,138, filed November 18, 1997, based upon applicant's allegation of a bona fide intention to use the mark in commerce.

[2] We note that applicant filed its main brief before the Examining Attorney's response to applicant's request for reconsideration.

that the appeal be suspended and the case be remanded for further examination. See TBMP § 1207.02. However, a timely request for reconsideration of an appealed action may be accompanied by additional evidence, and such evidence is not considered untimely submitted. See TBMP §1204. This is because a request for reconsideration filed during the six-month response period following issuance of a refusal is considered by the Board to have been filed prior to appeal. This section of the Board manual further provides:

> If the Examining Attorney, upon consideration of a request for reconsideration (made with or without new evidence), does not find the request persuasive, and issues a new final or nonfinal action, the Examining Attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought.

Accordingly, the Examining Attorney's evidence submitted with her response to applicant's request for reconsideration is considered appropriate. Applicant's evidence, submitted with its supplemental brief, even though stated to be in rebuttal of the Examining Attorney's evidence, cannot be accepted. If applicant had wanted to make the registrations of record, it should have sought remand under Rule 2.142(d). We should hasten to point out, however, that even if such evidence (copies of third-party

registrations wherein there was no disclaimer of the word "STATION") was considered, it would not change the result herein.

Finally, with respect to the dictionary definitions attached to the Examining Attorney's appeal brief, those are appropriate because we may take judicial notice of such definitions. See University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

In the first Office action, the Examining Attorney stated that applicant's mark was merely descriptive of its goods under Section 2(e)(1) of the Act, 15 USC § 1051(e)(1), because "the goods are a STATION for SCANNING."[3] In both the final refusal and the Examining Attorney's response to applicant's request for reconsideration, the Examining Attorney asserted that applicant's mark was merely descriptive of its goods because applicant's computer software would be used in connection with "scanning stations." In this regard, the Examining Attorney contends that the term "scanning station" is used

[3] In this refusal, the Examining Attorney also refused registration under Section 2(d) of the Act, 15 USC § 1052(d), on the basis of a registration covering the mark CF SCANSTATION, "SCANSTATION" disclaimed, for computer software for use in optical scanning. The Examining Attorney later withdrew that refusal.

as a generic term for "scanners" and that applicant's software would be used with these scanning stations. Accordingly, the Examining Attorney contends that applicant's mark is merely descriptive of the function or purpose of applicant's computer software.[4]

Some of the excerpts upon which the Examining Attorney relies are noted below:

> Payback: The multipurpose machines totally automated the scanning of resumes, transcripts, and writing samples into the Notes database, thereby eliminating stand-along scanning stations and saving the company $50,000 per year in printer consumables.
>
> PC/Computing, March 1, 2000
>
> * * * * *
>
> Each floor has two copy and equipment hubs that cluster Hewlett-Packard Co. LaserJet 8000 Series printers as well as Tektronix Inc. color printers and scanning stations.
>
> PC Week, October 25, 1999
>
> * * * * *
>
> Equipment applications include two manual encoding or manual laser scanning stations, or automatic laser scanning.
>
> Plant Engineering, September 30, 1999
>
> * * * * *

[4] In her brief, while maintaining that applicant's mark merely describes the purpose and function or use of applicant's goods, the Examining Attorney contends that applicant's software enables a personal computer to function as or to become a scanning station.

PPT Vision featured its PPT861 at SEMICON West, a high-speed, semi-automated 3D scanning station capable of 2.5 micron resolution. The PPT861 provides the flexibility to scan a wide range of in-tray semiconductor packages including...

NDT Update, August 1999

* * * * *

Recycle an older-generation PC and either add it to a network or attach an Iomega Zip... drive to it and turn it into a dedicated scanning station. Older PCs that have Pentium 300 MHz processors are very reasonably priced and are perfectly acceptable for basic tasks like scanning.

The Orange County Register, April 12, 1999

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This month and next, the Social Security Administration will get the remaining scanning stations for its Paperless Office Initiative.

Government Computer News, March 8, 1999

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Launch for Domino.Doc starts at $5,995 for a single indexing and scanning station...

Computer Reseller News, January 18, 1999

* * * * *

The NT-based system includes 60 APPLICATIONXTENDER workstations, a DISKXTENDER server, and three scanning stations equipped with Fujitsu scanners that can image up to 40 double-sided pages per minute.

Inform, January 1999[5]

[5] As the dissent notes, the evidence suggests that "scanning station" may be used to describe different types of equipment. We have not referred to the other usages in this opinion and

The Examining Attorney has also relied on various third-party registrations wherein the term "STATION" is either disclaimed, registered under Section 2(f) of the Act or placed on the Supplemental Register.

Applicant, on the other hand, argues that its mark is only suggestive because it requires imagination, thought and perception to reach a conclusion as to the nature of its goods. Essentially, applicant argues that "STATION" has no meaning with respect to computer software, that scanners and scanning stations are not computer software, and that the Examining Attorney has not introduced any evidence showing that "scanning station" is descriptive of *software*. Applicant also maintains that the Examining Attorney is incorrect when she maintains that its software will be able to transform computers into scanning stations.[6]

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believe that the fact that "scanning station" may be descriptive or generic of other goods is not relevant to this decision.

[6] We also note that applicant, during the time when the Examining Attorney had refused registration on the basis of the mark CF SCANSTATION, commented:

> The only similarity between the marks arises from the generic and/or merely descriptive term "scanstation" that appears in registrant's mark. Significantly, however, a disclaimer to exclusive rights to use "SCANSTATION" was entered in connection with the cited registration. Thus, the registrant does not have exclusive rights to the portion of the cited mark upon which the Trademark Attorney claims there is a confusing similarity.

Upon careful consideration of this record and the arguments of the attorneys, we conclude that applicant's asserted mark is merely descriptive of its computer software for use in connection with imaging scanners. The evidence noted above persuades us that the term "scanning station" may be used as an alternative way of describing or naming scanners. Therefore, the term "SCANNING STATION", used in connection with computer software for scanners or scanning stations is, as explained below, merely descriptive of the use or purpose of that software.

Most of the dissent criticizes the Examining Attorney, and appears to say that, if the Examining Attorney did not always correctly articulate how SCANNING STATION was descriptive of the goods, ordinary consumers for these goods will not see the mark as merely descriptive. There are obvious problems with this reasoning.

First, the determination as to whether a mark is merely descriptive of certain goods must be made on the basis of the perception of the consumers and potential purchasers for the identified goods, based on the evidence of record, and not on whether the Examining Attorney may have incorrectly described the precise nature and function

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Applicant's Amendment, filed March 29, 1999, p. 2. Later, applicant maintained that, even if the term "SCANSTATION" is

of applicant's goods in two instances during prosecution of the application. Although, as the dissent points out, Examining Attorneys are trained professionals, they are professionals in trademark law, not necessarily in the goods which with a mark being examined may be used or be intended to be used, such as computer software for imaging scanners.[7]

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merely descriptive, the Examining Attorney has not proven that "SCANNING STATION" is.

[7] Although not particularly relevant to this refusal, the dissent states that Examining Attorneys do not "examine all types of goods and services" but rather only "cover a particular, narrow range of goods or services," and that they are "highly learned individuals" in their particular range of goods or services. First, there are two law offices (those dealing with electronically filed applications, the E Commerce law offices) where Examining Attorneys do indeed examine all classes of goods and services. Moreover, even in the remaining law offices, all Examining Attorneys handle all types of service mark applications as well as goods in a number of classes representing different fields of endeavor. For example, some law offices, aside from handling service mark applications, examine goods in Classes 3, 16 and 28, covering such diverse and unrelated goods as bleaches, cleaning and polishing preparations, soaps, cosmetics, publications, stationery, artists' materials, playing cards, toys, games and Christmas tree ornaments. Even those Examining Attorneys who examine goods in Class 9 also examine goods in other classes. For Class 9, they may find themselves examining applications covering such a wide range of products as alarms, diving equipment, all kinds of scientific instruments, audio and video recorders, stereo equipment, gambling machines, fire trucks, football helmets, weather balloons, door bells, laboratory beakers, circuit breakers, cameras, computer hardware and software of all types, batteries, telescopes and binoculars, bullet-proof vests, contact lenses, eyeglasses, electric irons, electric hair curlers, clock radios, smoke detectors, door openers, jumper cables, highway safety cones, telephones and dog whistles, among other goods. As can be seen, these Class 9 goods alone are in a number of different fields of commerce, certainly not a "narrow range of goods or services." Suffice it to say that Examining Attorneys are not required to have, and may not necessarily possess, a technical background in the goods in the

Second, although the Examining Attorney did indeed acknowledge that her reasoning in the first Office action as to why the mark was merely descriptive was incorrect (that the mark was merely descriptive because "the goods are a STATION for SCANNING"), she did correctly state the reason in the final refusal and in the decision on applicant's request for reconsideration, and stated in her brief that the mark "merely describes the purpose and function of [applicant's] goods…" and "the purpose and use of the applicant's goods…" (brief, 3, 6).[8] Significantly, there is no question but that applicant was placed on notice as to the basis for the refusal.

While it is true, as the dissent notes, that software by itself cannot function as a scanner, it is also true that scanning hardware cannot work without the use of software. Software is needed to make a scanner function properly. Because the purpose or use of the computer software is to operate a scanner or scanning station, the term is merely descriptive of this purpose or use of the goods. We believe that a consumer for software for imaging

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applications before them. Nor are they necessarily "experts" in the operation or functioning of those goods. Moreover, in this particular intent-to-use case, it should be borne in mind that there are simply no specimens showing use of the mark or any product literature pertaining to the goods.

[8] The Examining Attorney also made the misstatements in her brief noted by the dissent.

scanners will know that the scanner requires software and, thus, upon seeing the mark SCANNING STATION used for software for imaging scanners, would immediately understand that the purpose of the software is to run the scanner or scanning station.

Overlooked, we believe, is that we must make a determination of mere descriptiveness on the basis of the evidence of record. A discussion of this evidence bearing on the issue of mere descriptiveness is conspicuously lacking from the dissent. If there is evidence of record demonstrating that the asserted mark is merely descriptive of its goods, then an application should not be allowed merely because the Examining Attorney may not have artfully articulated the precise reasoning for the refusal in the first Office action of this intent-to-use application, or made the technically incorrect statement in her brief that applicant's software "enable[s] a user to turn a personal computer into a SCANNING STATION to scan images."

Because we believe that the record adequately shows that the mark SCANNING STATION is merely descriptive of software used in connection with scanners or scanning stations, the refusal of registration is affirmed.

Hanak, Administrative Trademark Judge, dissenting:

I respectfully dissent. As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). Moreover, the immediate idea must be conveyed forthwith with a "degree of particularity." In re TMS Corp. of the Americas, 200 USPQ 57, 59 (TTAB 1978); In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd 90-1495 (Fed. Cir. February 13, 1991).

As noted by the majority, applicant seeks to register SCANNING STATION for "personal computer software for imaging scanners." (emphasis added). This identification of goods was set forth in applicant's initial application, and the identification has never been questioned by the examining attorney.

In her first Office Action dated September 28, 1998, the examining attorney contended that the mark SCANNING

STATION "merely describes the goods because the goods are a STATION for SCANNING." In her brief dated June 8, 2000, the examining attorney contended at page four "that the mark SCANNING STATION is merely descriptive of the applicant's software in that the purpose of the software for image scanners is to enable a user to turn a personal computer into a SCANNING STATION to scan images."

At the oral argument, the examining attorney conceded that the foregoing statements contained in her first Office Action and in her brief are absolutely wrong. Indeed, applicant had consistently attempted to educate the examining attorney as to the inaccuracy of her contentions. Applicant's computer software is simply not "a STATION for SCANNING." Applicant's computer software cannot scan anything. Moreover, applicant's computer software cannot "turn a personal computer into a SCANNING STATION to scan images." In order to scan images, one must have certain hardware, namely, a scanner. No amount of computer software will, by itself, allow one to scan images or to convert a personal computer into a scanner.

Despite having considered the application on at least four occasions,[9] the examining attorney, until the oral hearing, still had a totally erroneous view of the

[9] First Office Action; second Office Action; response to applicant's request for reconsideration; and preparation of her brief.

qualities and characteristics of applicant's computer software. Obviously, examining attorneys are highly trained professionals who scrutinize marks to a far greater degree than do ordinary purchasers. If after studying applicant's mark in relation to applicant's goods on at least four occasions, the examining attorney nevertheless came away with totally erroneous ideas as to the qualities or characteristics of applicant's goods, then I fail to see how it can be said with any degree of candor that an ordinary consumer, upon seeing applicant's mark in connection with applicant's goods, would forthwith gain an immediate idea of the qualities or characteristics of applicant's goods. At an absolute minimum, the inability of the examining attorney to correctly understand any quality or characteristic of applicant's computer software based upon a lengthy consideration of applicant's mark in relationship to applicant's goods indicates that there are doubts as to whether applicant's mark is merely descriptive of its goods. When such doubts exist, it has been the practice of this Board to resolve the doubts in favor of the applicant on the issue of mere descriptiveness. In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Some final comments are in order. The majority states that "most of the dissent criticizes the examining

attorney." This is simply not true. Earlier I noted that "examining attorneys are highly trained professionals" who perform their jobs with a great deal of care. To be perfectly clear, this comment was intended to apply not only to examining attorneys in general, but also to the particular examining attorney handling this case.

If there is any criticism directed at examining attorneys, the criticism comes not from the dissent, but rather from the majority. The majority correctly notes that a determination of whether a mark is merely descriptive must be made from the perspective of ordinary purchasers of the goods or services for which the mark is sought to be registered. The majority then goes on to note that examining attorneys are simply "professionals in trademark law, not necessarily in the goods which with a mark being examined may be used." In short, while not explicitly saying so, the majority is implicitly saying that compared to ordinary purchasers, examining attorneys are not as knowledgeable about the goods or services which they deal with on a daily basis. While this may be true with regard to highly specialized goods such as heart implant devices, it certainly is not true with regard to common office products such as scanners.

Thus, if an examining attorney carefully studies a mark used in connection with common goods or services and still is unable to correctly identify any quality or characteristic of such goods or services, then I simply fail to see how it can be said that an ordinary consumer would be able to immediately and correctly identify any quality or characteristic. This is particularly true given the fact that ordinary consumers spend just a matter of seconds glancing at a mark, whereas examining attorneys carefully scrutinize marks.

One additional point needs to be clarified. Had the examining attorney simply misconstrued the qualities or characteristics of applicant's goods in the first Office Action and then later corrected herself, I would not be dissenting. However, the examining attorney's misunderstanding of the qualities and characteristics of applicant's software continued throughout the examination process and indeed even in her brief. The majority would have one believe that the examining attorney "got it right" at all times after the first Office Action. This is simply wrong. As noted earlier, in her brief dated June 8, 2000 the examining attorney contended at page four "that the mark SCANNING STATION is merely descriptive of the applicant's software in that the purpose of the software

for image scanners is to enable a user to turn a personal computer into a SCANNING STATION to scan images." As previously noted, this is a totally erroneous statement. Moreover, the examining attorney at the oral hearing conceded that it is a totally erroneous statement.[10]

[10] Footnote 7 of the majority opinion is perplexing because the dissenting opinion does not contain the statements set forth in the first sentence of footnote 7.